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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/596,086 | 06/16/2000 | Elfi Biedermann | 69054 | 3172 |

22242 7590 09/13/2004

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CHICAGO, IL 60603-3406

EXAMINER

COLEMAN, BRENDA LIBBY

| | |
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| ART UNIT | PAPER NUMBER |
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1624

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|--------------------------------------|--|--|
| Advisory Action | Application No. 09/596,086 | Applicant(s) BIEDERMANN ET AL. | |
| | Examiner Brenda Coleman | Art Unit 1624 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 55-77.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Claims 55-77 are pending in the application.

The period for reply continues to run FIVE MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

The amendment filed August 26, 2004 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

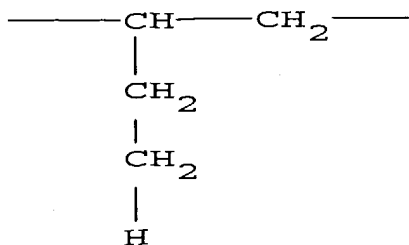
1. With regards to the objection to the Information Disclosure Statement the applicants stated that a Supplemental IDS that addresses the objections raised by the Examiner is submitted herewith. However, as stated in the last office action a Supplemental IDS still has not been received.
2. With regards to the 35 U.S.C. § 102, anticipation rejection labeled paragraph 11 of the last office action, the applicants stated that Saito et al. cannot anticipate the compounds and compositions of the present invention because D cannot represent –

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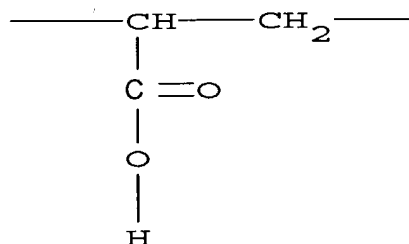
CH(CO₂H)-CH₂-CH₂- as carboxylic acid does not represent a substituent of the C₃-C₁₂-alkylene group. The definition of D is such that D is selected from the group consisting of C₃-C₁₂-alkylene, a substituted C₃-C₁₂-alkylene which is substituted once or twice by C₁-C₆-alkyl, hydroxy, C₁-C₆-alkoxy or phenyl, C₃-C₁₂-alkenylene, a substituted C₃-C₁₂-alkenylene which is substituted once or twice by C₁-C₆-alkyl, hydroxy, C₁-C₆-alkoxy or phenyl, C₅-C₁₂-alkadienylene, substituted C₅-C₁₂-alkadienylene which is substituted once or twice by C₁-C₆-alkyl, hydroxy, C₁-C₆-alkoxy or phenyl, C₃-C₁₂-alkynylene, a substituted C₃-C₁₂-alkynylene which is substituted once or twice by C₁-C₆-alkyl, hydroxy, C₁-C₆-alkoxy or phenyl, C₅-C₁₂-alkeninylenylene, a substituted C₅-C₁₂-alkeninylenylene which is substituted once or twice by C₁-C₆-alkyl, hydroxy, C₁-C₆-alkoxy or phenyl, and C₃-C₁₂-alkylene, C₃-C₁₂-alkenylene or C₃-C₁₂-alkynylene, wherein, with the exception of the (G)-terminal methylene group in the C₃-C₁₂-alkylene, C₃-C₁₂-alkenylene or C₃-C₁₂-alkynylene, one to three methylene units in the C₃-C₁₂-alkylene, C₃-C₁₂-alkenylene or C₃-C₁₂-alkynylene are isosterically replaced by O, S, NR⁷, CO, SO or SO₂, wherein R⁷ is selected from the group consisting of hydrogen, C₁-C₆-alkyl, C₁-C₆-alkenyl, C₁-C₆-acyl, and C₁-C₆-alkanesulfonyl. Saito teaches D can be interpreted various ways with different substituents or isosterically replacements possible. The applicants stated that D cannot be substituted and isosterically replaced, however, there was just one interpretation of the definition of D presented in the last office action. D can also be as follows:

- a. D is C₄-alkylene, i.e.

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- b. With the exception of the (G)-terminal methylene group in the C₄-alkylene, one to three methylene units in the C₄-alkylene are isosterically replaced by O and CO, i.e.



- d. The end product as taught by Saito, i.e. -CH(CO₂H)-CH₂-.

Claims 55, 60 and claims dependent thereon are rejected under 35 U.S.C.

102(b) as being anticipated by Saito et al., (J. Enzyme Inhib.) for reasons of record and stated above.

In view of the non-entry of the amendment all rejections (i.e. labeled paragraphs 12-17 and 19-30 are herein maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
September 10, 2004